

REMARKS

This Amendment and Request for Reconsideration is filed in response to the Office Action mailed on 9 January 2006 for the above-referenced patent application.

In the present Amendment, the Applicants amend claims 1, 3, and 14 and add new claims 22-33. The Applicant submits that no new matter has been added by the amendment of claims 1, 3, and 14 and by adding new claims 22-33. No claims have been canceled. The Applicants hereby respectfully request entry of this Amendment and reconsideration of the claims as amended and as well as the new claims.

In the Office Action mailed on 9 January 2006, the Examiner confirmed the restriction requirement associated with Group I claims 1-13 (method of making a read head) and Group II claims 14-21 (method of forming a read sensor for a magnetic head). The Applicant hereby affirms the election of Group I claims 1-13 with traverse.

In the written restriction, the Examiner states that Group I and Group II claims are related as subcombinations and that subcombinations are distinct from each other if they are shown to be separately usable. The Examiner further reasons that the Group II claims of the present application have a separate utility such as ion milling, and therefore restriction of claims is appropriate.

In response, the Applicant respectfully disagrees with the restriction requirement and the Examiner's characterization of the claims. First, Group I claims and Group II claims are actually combination and subcombination claims, where the subcombination (Group I claims) is essential to the combination (Group II claims). Specifically, the limitations of independent method claim 1 are recited in independent method claim 14. Note that if there is no evidence that the combination (Group II claims) is patentable without the details of the subcombination (Group I claims), then restriction should not be required. This is true even if the subcombination has separate utility. See MPEP § 806.05(c), part II. Therefore, the restriction of claims in this application as urged by the

Examiner is not required. Secondly, the Applicant amends claims 1 and 14 to recite a "method for use in making a read head" for consistency in classification in class 29, subclass 603.01. The title has been similarly amended. As apparent, the classification status is the same for both claim groups and therefore restriction cannot be required for reasons of different classification.

Therefore, the Applicant respectfully submits the Examiner to withdraw the requirement for restriction and include claims 1-21 as amended (Group I and II) for present examination.

In the Office Action mailed 9 January 2006, the Examiner rejected claims 1-4 under 35 U.S.C. § 103(a) based on Lin (U.S. Patent No. 5,949,623) in view of Tanaka et al. (U.S. Patent No. 6,617,265) and further in view of Mitsuru Ura (U.S. Patent No. 3,602,778). Also in the Office Action, the Examiner indicated allowable subject matter in claims 5-13.

In response, the Applicant respectfully acknowledges the Examiner's indication of allowability of dependent claims 5-13 and submit that the invention as defined by such claims should be broadly protected as warranted by law. As provided herein, the Applicant presents new independent claim 23 which corresponds to indicated-allowable dependent claim 5 and also presents new independent claim 28 which corresponds to indicated-allowable dependent claim 9. Therefore, new independent claims 23 and 28 as well their dependent claims 24-27 and 29-33 are allowable over the prior art of record.

On the other hand, the Applicant respectfully disagrees with the rejection of claims 1-4 under 35 U.S.C. § 103(a). In particular, the Examiner has failed to make a prima facie case that the invention as defined by claims 1-4 is obvious over the cited prior art. For one, the cited references fail to teach or suggest the step of selectively depositing the lead layers with use of the silicon reduction process. Furthermore, the Examiner has failed to articulate, with any precision whatsoever, where the limitations of the claims pertaining to the silicon reduction process can be found in the above-cited references. For rejecting claim 1, the Examiner merely states that:

“Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin (US 5,949,623) In view of Tanaka et al (US 6,617,265) and further in view of Mitsuru Ura (US 3,602,778). As applied to claim1, Lin discloses a method of making a read head, comprising: forming a read sensor which is abutted by longitudinal bias layers (63, 64, Fig. 7); and selectively depositing lead layers (70, 71) over the longitudinal layers. However, **the modified Tanaka et al.** does not disclose using a hydrogen reduction process.” (Emphasis Added)

As apparent, the Examiner essentially ignores the limitations regarding the silicon reduction process, and has failed to identify or articulate any proposed modification of any reference (such as Tanaka et al.) to identify any selective deposition of lead layers using a silicon reduction process. The Applicant respectfully submits that the Examiner has failed in this regard because the prior art of record indeed fails to teach or suggest such limitations and render the invention obvious. In any event, it is not possible for the Applicant to respond adequately to any 35 U.S.C. § 103(a) rejection without it being articulated.

The Examiner has also failed to identify and articulate any suggestion or motivation to combine the teachings in the Lin and Tanaka et al. references. Tanaka et al. relates to a technique for use in making a photomask for transferring an integrated circuit pattern onto a wafer – not a technique for use in making a read head of the present application. Note that some claims of the present invention are specifically directed to the selective deposition of lead layers *without* using any photoresist mask (which is Tanaka’s primary focus). For at least these reasons, the Applicant respectfully submits that there is no adequate suggestion or motivation to combine the Tanaka et al. reference with the Lin reference.

The Examiner has also failed to identify and articulate any motivation or suggestion to combine the Mitsuru Ura reference with the other references. The Mitsuru Ura reference is dated back about 35 years ago and relates to a method of making a Zener diode. The Applicant respectfully submits that methods for use in making Zener diodes and methods for use in making magnetic read heads are non-analogous arts. Even if the

Mitsura Ura reference could be utilized for such a rejection, Mitsura Ura teaches or suggests no lead layer material deposited with use of a hydrogen reduction process, rather only the specific compounds described to make the PN junctions of a Zener diode (e.g. col. 4 at lines 27-58) and not its leads. Again, in any event, it is not possible for the Applicant to respond adequately to any 35 U.S.C. § 103(a) rejection without any suggestion or motivation to combine being articulated.

Since the Examiner has failed to make a prima facie case of obviousness under 35 U.S.C. § 103(a), because the prior art fails to teach or suggest all of the claim limitations and render the invention obvious, the Applicant respectfully requests the Examiner to withdraw all rejections of claims and allow the present application.

The Applicants respectfully request entry of the amendment and reconsideration of all pending claims. The Applicants respectfully submit that the application as amended is now in a condition suitable for allowance.

Thank you. The Examiner is invited to contact the undersigned if necessary to expedite allowance of the present application.

Date:

12 April 2006

Respectfully Submitted,

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